UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,335	07/01/2004	David S. Bonalle	70655.3200	4334

20322 7590 08/08/2005	EXAMINER
SNELL & WILMER	WALSH, DANIEL I

ONE ARIZONA CENTER	ART UNIT	PAPER NUMBER
400 EAST VAN BUREN	2876	
PHOENIX, AZ 850040001		

DATE MAILED: 08/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/710,335	BONALLE ET AL.
	Examiner	Art Unit
	Daniel I. Walsh	2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *01 July 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____ .

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date *7-04, 8-04*.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

DETAILED ACTION

1.   Receipt is acknowledged of the IDS received on 1 July 2004 and 5 August 2004.

Double Patenting

2.   Claims 1-12 are provisionally rejected under the judicially created doctrine of

obviousness-type double patenting as being unpatentable over claims 1-12 of copending

Application No. 10/708,841, hereinafter '841. Although the conflicting claims are not identical,

they are not patentably distinct from each other because the '841 Patent Application has claims

that are identical, except for the '841 being drawn to a transponder and not a smartcard.

However, the Examiner notes that a smartcard and transponder are well known and conventional

in the art, and the selection of a smartcard/transponder is well within the ordinary skill in the art,

as an alternative means for portable communication, based on design/system constraints, for

example (cost, distance of communication, portability, convenience, etc.).

For instance, in claim 1 of the present claimed invention and claim 1 of the '841 Patent

Application, the Applicants claim:

i) "...smartcard transaction system...notifying a user...detecting a

proffered...verifying...violate a rule...biometric sample." (see claim 1), whereas in the

'841 Patent Application the Applicants claim "...transponder-reader system...notifying a

user...detecting a proffered...verifying...violate a rule...biometric sample." (see claim 1)

For instance, in claim 1 of the present claimed invention and claim 1 of the '841 Patent

Application, the Applicants claim:

   i) "...smartcard transaction system...notifying a user...detecting a

   proffered...verifying...violate a rule...biometric sample." (see claim 1), whereas in the

   '841 Patent Application the Applicants claim "...transponder-reader system...notifying a

   user...detecting a proffered...verifying...violate a rule...biometric sample." (see claim 1)

For instance, in claim 2 of the present claimed invention and claim 2 of the '841 Patent

Application, the Applicants claim:

   ii) "...established rule...established limit." (see claim 2), whereas in the '841 Patent

   Application the Applicants claim "...established rule...established limit." (see claim 2)

For instance, in claim 3 of the present claimed invention and claim 3 of the '841 Patent

Application, the Applicants claim:

   iii) "...notification...beeping to said user." (see claim 3), whereas in the '841 Patent

   Application the Applicants claim "...notification...beeping to said user." (see claim 3).

For instance, in claim 4 of the present claimed invention and claim 4 of the '841 Patent

Application, the Applicants claim:

   iv) "...detecting...and network." (see claim 4), whereas in the '841 Patent Application

   the Applicants claim "...detecting...and network." (see claim 4).

For instance, in claim 5 of the present claimed invention and claim 5 of the '841 Patent Application, the Applicants claim:

v) "…detecting…proffered biometric sample." (see claim 5), whereas in the '841 Patent Application the Applicants claim "…detecting…proffered biometric sample." (see claim 5).

For instance, in claim 6 of the present claimed invention and claim 6 of the '841 Patent Application, the Applicants claim:

vi) "…finite number…during a transaction." (see claim 6), whereas in the '841 Patent Application the Applicants claim "…finite number…during a transaction." (see claim 6).

For instance, in claim 7 of the present claimed invention and claim 7 of the '841 Patent Application, the Applicants claim:

vii) "…logging each proffered…" (see claim 7), whereas in the '841 Patent Application the Applicants claim "…logging each proffered…" (see claim 7).

For instance, in claim 8 of the present claimed invention and claim 8 of the '841 Patent Application, the Applicants claim:

viii) "…second proffered biometric sample." (see claim 8), whereas in the '841 Patent Application the Applicants claim "…second proffered biometric sample." (see claim 8).

For instance, in claim 9 of the present claimed invention and claim 9 of the '841 Patent

Application, the Applicants claim:

ix) "...comparing...stored biometric..." (see claim 9), whereas in the '841 Patent

Application the Applicants claim "...comparing...stored biometric..." (see claim 9).

For instance, in claim 10 of the present claimed invention and claim 10 of the '841 Patent

Application, the Applicants claim:

x) "...comparing....criminal, a terrorist, and a cardmember." (see claim 10), whereas in

the '841 Patent Application the Applicants claim "...comparing....criminal, a terrorist,

and a cardmember." (see claim 10).

For instance, in claim 11 of the present claimed invention and claim 11 of the '841 Patent

Application, the Applicants claim:

xi) "...verifying...third-party controlled database." (see claim 11), whereas in the '841

Patent Application the Applicants claim "...verifying...third-party controlled database."

(see claim 11).

For instance, in claim 12 of the present claimed invention and claim 12 of the '841 Patent

Application, the Applicants claim:

xii) "...third-party security vendor." (see claim 12), whereas in the '841 Patent

Application the Applicants claim "...third-party security vendor." (see claim 12).

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting

claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
such that the subject matter as a whole would have been obvious at the time the invention was made to a person
having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the

claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)

and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3.   Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Renner et al.

(US 6,223,984) in view of Black (US (US 2005/012209) and Janiak et al. (US 2002/0030581).

        Renner et al. teaches that a optional PIN keypad can be used in order to force a user to

enter a personal identification number (PIN) to authorize transactions above a certain limit (FIG.

7, 734). This is interpreted as determining if a transaction violates an established rule, and

authorizing the transaction that violates an established rule upon PIN verification.

Renner et al. teaches PIN verification, and therefore is silent to notifying a user to proffer

a biometric sample, detecting a biometric sample at a sensor communicating with the system to

obtain a proffered biometric sample, verifying the biometric sample, and authorizing the

transaction upon verification of the sample (col 13, lines 33+). Re claim 2, Renner et al. teaches

transactions above $10 for example, require a PIN. This is broadly interpreted as the transaction

exceeding an established limit.

Black teaches replacing PIN codes with fingerprint matching. Black teaches detecting a

proffered biometric at a sensor communicating the system to obtain a proffered biometric

sample; verifying the proffered biometric sample, and authorizing a transaction (FIG. 1C). Re

claim 4, Black teaches the step of detecting includes detecting a proffered biometric at a sensor

configured to communicating with the system via at least one of a smartcard, reader, and

network (FIG. 1C). Re claim 5, the Examiner notes that it is obvious that the step of of detecting

includes at least one of detecting, storing, and processing a proffered biometric sample (FIG.

1C). Re claim 6, the Examiner notes that a finite number of proffered biometrics are received

during a transaction (for example, 1 fingerprint). Re claim 7, Black teaches that samples are

logged/stored (transaction record paragraph [0126]). The Examiner also notes it's an obvious

expedient to keep a log/record of transactions and associated data/information for record keeping

purposes. Such logging/recording is conventional with credit card transactions where a signature

is captured and stored in addition to credit card numbers, and therefore simply logging the

biometric data, which is used for enhanced security, is an obvious expedient. Re claim 8, FIG.

1C teaches detecting/processing/storing at least one second proffered biometric sample (as both

the electronic and digital signatures are captured). Re claim 9, FIG. 1C teaches comparing a

proffered sample with a stored sample for verification. Re claim 10, Black teaches that a

comparison between a proffered biometric sample and stored biometric samples includes

comparing samples with a sample of at least one of a criminal, terrorist, and cardmember (FIG.

1C), as it is obvious that a proffered biometric is compared to cardmembers to verify that the

biometric matches the cardmember. Re claim 11, the Examiner notes that Black teaches

embodiments where the biometric data can be stored on the portable device itself, or remotely

(paragraph [0090]+). Accordingly, based upon the desired security, verifying the sample could

either use information contained on at least one of a local database, remote database, and a third

party controlled database. For example, in the case where the information is stored remotely, the

Examiner notes it would have been an obvious expedient to store the information in a database,

since databases are well known and conventional in the art, for storing and arranging data that

can be fetched and accessed quickly and reliably. Therefore, storing the information on a

database is an obvious expedient. Re claim 12, Black teaches the step of verifying includes

verifying a proffered biometric sample using one of al local CPU and third party security vendor

(FIG. 1C and claim which teaches a local processor/CPU verifying samples). Though Black in

some embodiments is drawn to a RFID/transponder, the Examiner notes that Black states that

such teachings can apply to smartcards as well (abstract).

At the time the invention was made, it would have been obvious to one of ordinary skill

in the art to combine the teachings of Renner et al. with those of Black.

One would have been motivated to do this to have a more secure means of authorizing a

transaction that breaks a rule.

Though Renner et al./Black are silent to notifying a user to proffer a biometric sample

(audlbly/visusally/mechanically/etc. re claim 3) the Examiner notes that it is well known and

conventional to provide instructions/notifications to a user engaged in a card transaction, in order

to guide them to facilitate completion of the transaction. This is especially well known and

conventional with standard credit card transactions where a user interfaces with a terminal that

displays instructions to the user.

Specifically, Janiak et al. teaches requesting biometric data by a display to a user, to

facilitate a transaction (see claim 45 of Janiak et al., for example).

At the time the invention was made, it would have been obvious to combine the teachings

of Renner et al./Black with those of Janiak et al.

One would have been motivated to do this to provide instructions to assist the completion

of the transaction.
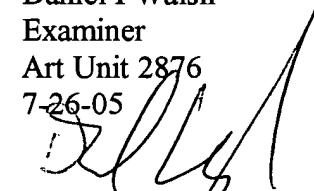
Conclusion

4.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure: Rast (US 2003/0208439), Bonneau, Jr. (US 5,581,630), Higuchi (US 2005/0036665),

Peart et al. (US 2005/0033688), Lee (US 2003/0001006), Kotzin (US 2004/0257196), Roy et al.

(US 2002/0133725), Hoffman et al. (US 2002/0111917), Matyas et al. (US 6,697,947), Bjorn et

al. (US 2004/0258282), Cassone (US 2004/0188519), Sano et al. (US 2004/0161135), Price-

Francis (US 5,815,252), Ray et al. (US 5,321,751), Sparrow et al. (US 4,747,147), and Suzuki

(JP02004164347A).

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The

examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel I Walsh
Examiner
Art Unit 2876
7-26-05